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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/450,558	11/30/1999	MICHAEL E. CARROLL	52817.000076	7836

29315 7590 03/24/2003

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[REDACTED] EXAMINER

BIENEMAN, CHARLES A

ART UNIT	PAPER NUMBER
2176	[REDACTED]

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/450,558	CARROLL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Charles A. Bieneman	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 30 November 1999.  
 2a) This action is FINAL.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-16 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 30 November 1999 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____    | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This action is responsive to the following communication: original application filed on November 30, 1999.
2. Claims 1-16 are pending. Claims 1, 6, 11, and 14 are independent claims.

### ***Drawings***

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: page 12, lines 15-23 of the specification refer to reference 200 as being in Figures 8(a) and 8(b), but the reference number is not present in either of these figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. With respect to the rejection of each dependent claim below, the preceding rejection(s) of the relevant base claim(s) is incorporated therein.

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7. **Claims 1-2, 6-7, 11 and 14** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 5,987,480 to Donohue et al., issued November 16, 1999, filed July 25, 1996.

Regarding **independent claim 1**, Donohue et al. disclose a data storage mechanism that stores the main document with a formula that resolves to a reference to an insert document. (Donohue et al., col. 6, lines 10-13: "The web page templates 24 stored on the web server 10 are markup language documents containing a number of dynamic content tags 34 and flow directives 36 embedded therein.")

Further, Donohue et al. disclose a shared resource database, accessible by a plurality of clients of the system, that stores one or more insert documents that may be referenced within the main document. (Donohue et al., col. 7, lines 37-41: "In some embodiments, the data source 12 is a relational database and includes a database storing content to be inserted into the templates 24 and a database management system for creating database structures, declaring data relationships, and performing database operations.")

Further, Donohue et al. disclose a document destination module that opens the main document and extracts the formula inasmuch as Donohue et al. teach a template parsing function. (Donohue et al., col. 10, lines 49-55: "The contents of the selected template are then retrieved, step 56, either all at once or by loading sections of the template sequentially into a buffer. The template parsing function 18 then reads the contents of the template to locate the "@" control symbols, step 58, and identifies the character string surrounded by the control symbols as a dynamic tag, IF instruction or LOOP instruction, step 60.")

Further, Donohue et al. disclose a formula resolution module that resolves the formula to derive a value for the reference, a document retrieval module that uses the reference to retrieve

the insert document, and a document insertion module that inserts the insert document into the main document in a document location point specified. (Donohue et al., col. 10, lines 60-65: "For a dynamic tag, the template parser 18 calls the appropriate library function 22 to retrieve the value corresponding to the name in the tag from the container, step 62, and replace the dynamic tag, including the name and control symbols, with the value retrieved from the container, step 64.")

Regarding **independent claim 6**, Donohue et al. disclose storing a main document with a formula that resolves to a reference to an insert document. (Donohue et al., col. 6, lines 10-13, quoted above.)

Further, Donohue et al. disclose storing one or more insert documents that may be referenced within the main document. (Donohue et al., col. 7, lines 37-41, quoted above.)

Further, Donohue et al. disclose retrieving and opening the main document. (Donohue et al., col. 10, lines 49-51, quoted above.)

Further, Donohue et al. disclose resolving the formula to derive a value for the reference, using the reference to retrieve the insert document, and inserting the insert document into the main document in a document insertion point. (Donohue et al., col. 10, lines 60-65, quoted above.)

Regarding **independent claim 11**, the rejection of claim 6 above is fully incorporated herein.

Further, Donohue et al. disclose extracting the formula from the main document. (Donohue et al., col. 10, lines 51-55, quoted above.)

Regarding **independent claim 14**, the rejection of claim 1 above is fully incorporated herein.

Further, Donohue et al. disclose a computer useable medium having computer readable code embodied therein. (Donohue et al., col. 6, line 2 – col. 3, line 24.)

Regarding **dependent claims 2 and 7**, Donohue et al. teach a document identification module and means that receives the reference and determines the name of the insert document to be retrieved based on the reference inasmuch as Donohue et al. teaches retrieving “the value corresponding to the name in the tag from the container.” (Donohue et al., col. 10, lines 61-62.)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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10. **Claims 3, 8, 12, and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al. in view of U.S. Patent Number 6,226,648 B1 to Appleman et al. issued May 1, 2001, earliest effective filing date February 6, 1998.

Donohue et al. do not teach enabling a user to create the main document with the reference to the insert document and storing the main document with the reference separately from the insert document being referenced. However, Appleman et al. teach creation and uploading of HTML templates by a user (Appleman et al., col. 7, lines 51-54) wherein the templates contain references to included files, *i.e.*, insert documents. (Appleman et al., col. 8, lines 29-45.) Further, Appleman et al. would have motivated one of ordinary skill in the art to take this step inasmuch as they teach that their approach eliminates or reduces the need to hard code design elements in a web page, promoting greater “design and maintenance flexibility.” (Appleman et al., col. 9, lines 22-41.) Therefore, it would have been obvious to one of ordinary skill in the art to have enabled a user to create the main document with the reference to the insert document and store the main document with the reference separately from the insert document being referenced.

11. **Claims 4, 9, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al. and Appleman et al. and further in view of U.S. Patent Number 6,006,242 to Poole et al., issued December 21, 1999, filed April 5, 1996.

Neither Donohue et al. nor Appleman et al. teaches enabling a user to define the formula that resolves to the reference to the insert document to be included in the main document. However, Poole et al. does teach such a limitation. (Poole et al., col. 5, lines 7-10: “Each of the constituent portions of the document is associated with an entity reference which is selected by

the document developer, as is indicated at step 34.”) Moreover, one of ordinary skill in the art would have recognized that the user would have needed the ability to define the formula that resolves to the reference to the insert document to be included in the main document in order to ensure that the appropriate insert document was inserted. Therefore, it would have been obvious to one of ordinary skill in the art to enable a user to define the formula that resolves to the reference to the insert document to be included in the main document.

12. **Claims 5 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al. in view of World Wide Web Consortium, *HTML 3.2 Reference Specification*, W3C Recommendation 14 January 1997, pages 1-7, found online on March 18, 2003 at [www.w3.org/TR/REC-html32](http://www.w3.org/TR/REC-html32) and Appleman et al.

Donohue et al. do not teach that the document location point comprises a background in the main document. However, *HTML 3.2 Reference Specification* teaches on page 6 that background is an attribute of HTML’s <BODY> element, and further teaches on page 7 that the background attribute can be used to specify a URL (equivalent to a formula) “for an image that will be used to tile the document background.” Moreover, Appleman et al. would have provided motivation to one of ordinary skill in the art to make background a document location point because Appleman et al. teaches the benefits of being able to soft-code design elements (Appleman et al., col. 9, lines 22-41), and one of ordinary skill in the art would have recognized that background is a design element. Therefore, it would have been obvious to one of ordinary skill in the art to have the document location point comprise a background in the main document.

13. **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al. in view of Poole et al.

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Donohue et al. do not teach enabling a user to define the formula that resolves to the reference to the insert document to be included in the main document. However, Poole et al. does teach such a limitation. (Poole et al., col. 5, lines 7-10: "Each of the constituent portions of the document is associated with an entity reference which is selected by the document developer, as is indicated at step 34.") Moreover, one of ordinary skill in the art would have recognized that the user would have needed the ability to define the formula that resolves to the reference to the insert document to be included in the main document in order to ensure that the appropriate insert document was inserted. Therefore, it would have been obvious to one of ordinary skill in the art to enable a user to define the formula that resolves to the reference to the insert document to be included in the main document.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

<b>U.S. Patent Number</b>	<b>Name</b>	<b>Issue Date</b>	<b>File Date</b>	
6,397,231 B1	Salisbury et al.	5/28/02	8/31/98	
6,192,382 B1	Lafer et al.	2/20/01	9/24/97	
6,031,989	Cordell	2/29/00	2/27/97	
6,021,202	Anderson et al.	2/1/00	12/19/97	
5,991,782	Miyagawa et al.	11/23/99	12/16/97	
5,659,676	Redpath	8/19/97	n/a	

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Bieneman whose telephone number is 703-305-8045. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

CAB

March 18, 2003

*Heather Herndon*  
HEATHER R. HERNDON  
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